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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,338	11/02/1999	KLAUS ZIMMERMANN	10191/1157	9914
26646	7590	05/23/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			KEASEL, ERIC S	
			ART UNIT	PAPER NUMBER

3753

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/432,338

Applicant(s)

ZIMMERMANN ET AL.

Examiner

Eric Keasel

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/20/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 91-102 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 91-102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Figure 1 of the instant application (i.e. the only figure that shows the claimed apparatus) is the same as Figure 1 of UK Patent Application GB 2311559A.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 91-102 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly added claims introduce new matter in that the claims now require “specifying a duration of the time window so that a current which flows through the consumer during the time window does not exceed a threshold value”. In the originally filed application, this duration was not specified, but it was determined through a process. Simply specifying this time window is not supported by the originally filed application because the application at one point dealt with how this duration was determined and changed rather than merely specifying it.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 91-102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The newly added claims are indefinite as the limitations “specifying a duration of the time window so that a current which flows through the consumer during the time window does not exceed a threshold value” appears to directly contradict the two other limitations in the independent claims (i.e. increasing or decreasing the duration).

6. In light of the above informalities, the claims have been examined as could best be understood by the examiner. The examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 91-102 (as understood and at least to the extent the claims are supported by the originally filed application) are rejected under 35 U.S.C. 102(b) as being anticipated by Rehlichler (US Patent Number 5,592,921).

Rehlichler discloses the method and the corresponding apparatus of activating a solenoid valve for controlling metering of fuel into an internal combustion engine. The switching instant is determined by analyzing the variation over time of the current (see column 2, lines 5-10 and column 3, lines 41-44). The current is determined throughout the time window including the time “immediately before” the end of the time window. The duration of the time window varies in relation with the current such that the time window is reduced (i.e. the switching means is opened) when current exceeds a threshold value and is increased when the current is below the threshold value (see column 4, lines 12-24).

9. Claims 91-102 (as understood and at least to the extent the claims are supported by the originally filed application) are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer et al. (GB 2311559 A).

Fischer et al. disclose the method and the corresponding apparatus of activating a solenoid valve for controlling metering of fuel into an internal combustion engine. The

switching instant is determined by analyzing the variation over time of the current (see page 2, lines 1-5). The current is determined throughout the time window including the time “immediately before” the end of the time window. The duration of the time window varies in relation with the current such that the time window is reduced when current exceeds a threshold value and is increased when the current is below the threshold value (see page 1, lines 18-21, page 6, lines 8-12).

### *Response to Arguments*

10. Applicant's arguments filed March 20, 2006 have been fully considered and are either moot in view of the new grounds of rejection or are not persuasive.

Applicant argues that a prior art label should not be included for Fig. 1 because the specification does not explicitly state that it is prior art. This argument is not germane to the issue at hand. Fig. 1 of the present application is identical to Fig. 1 of GB2311559A. Not only is the same identical device depicted, the same reference numerals are used to identify each of the identical parts. Therefore, it is prior art irregardless of whether applicant's specification states so or not.

Applicant argues that the limitations set forth in the second to fourth steps in claim 91 (and similar limitations in claim 97) have support and are not contradicting. The examiner disagrees. The second step requires that the duration of the time window be specified so that the current does not exceed a threshold value. If the time window has already been specified so that the current does not exceed a threshold value, what is step four supposed to mean and where does this combination of limitations have support in the specification?

Applicant argues that Rehlichler only changes the load or current and does not change a time window. The examiner disagrees. Please note claim 1 of GB2311559A, which defines a time window and enlarges the time window if the current related to the switching instant is not recognized within the window (i.e. it is below a threshold value). The window is enlarged by increasing the start instant (see claim 2) and the window is decreased by gradually reducing the start instant (see claim 4) when the current exceeds a threshold value related to recognizing the switching instant.

Applicant presents similar arguments with respect to Fischer that are not persuasive. However, it should be noted that applicant appears to be reading narrow limitations into the overly broad recitation of "threshold value". The claims do not define this threshold to be anything that would distinguish over the applied references.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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12. Any inquiry concerning this communication should be directed to Eric Keasel at telephone number (571) 272-4929, who can normally be reached Monday-Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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